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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,900	08/20/2001	Claudia Dorenkamp	LNUP:105_US_	8067

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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,900

Applicant(s)

DORENKAMP ET AL.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20 and 22-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-20 and 22-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3-6,9-13,18-20,22-25, 28-32 and 39-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heid et al.

Heid et al. teach an automated apparatus(1) for treating cytological or histological specimens. Column 3 lines 8+ describe the apparatus(1) as computer controlled for automatically running stored and selected treatment programs. The programs provide instructed a transport device to move the samples to individual treatment stations, remove the sample after the appropriate residence time and transport to the next/new treatment station. Each treatment station is selected according to the specific computer program required. The computer control can be set up for the simultaneous, parallel course of different and/or like treatment programs. The apparatus has a housing(1a) with two openings(4,5) that act as loading or unloading stations. The computer processor(31), memory(32), display field(2) and keyboard(3) are all integrated with the apparatus(1). A basket with specimen holder baskets is inserted is inserted into the loading station and acts as a transport unit taking the sample to the appropriate treatment station (column 4 lines 1+). The treatments stations(6a-j) are arranged in a two dimensional array. Two horizontal guides(8a-b) facilitate sample transport to the treatment stations(6a-j). The transport device(33-36) has four drives and via interface cards(33-36) the exact position of transport device is known at all times.

The claimed "multiple processing stations" have been read on the taught treatment stations(6a-j) and the claimed "transport device" on the taught transport devices(33-36). Heid et al. teach each treatment station is selected according to the specific computer program and has been read on the claimed "specific function".

Heid et al. teach specific placement of the treatment stations and interface cards(33-36) that define these locations of the treatment stations and permit controlled access to each station. Column 5 lines 9-12 teach the air can be evacuated from housing(1a).

The claimed "robotic arm having a gripper located ..." has been read on the taught two horizontal linear guides(8a-b), movable cross bar(9), vertical guide(10) and movable slider(11).

Claims 1,3-6,9-13,18-20,22-25, 28-32 and 39-43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Thiem et al. (USP 6,635,225).

Thiem et al. teach an automated apparatus for the cytological/histological staining of tissue samples comprising a transport basket(4) containing multiple slides(2), reagent containers(3), transport mechanism(6), transporting arms(24), sensors(12) and control/logic circuits(24/25). This has been read on the claimed multiple modular processing stations and transport device to move the sample in and out of the processing stations.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 7-8, 14-15, 26-27 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heid et al. or Thiem et al. (USP 6,635,225).

See Heid et al. and Thiem et al. (USP 6,635,225) supra.

The art is silent to the claimed attachment of the processing stations by bolts or clamped by a bracket, indication of a sample in the loading station by acoustically or optically means and a loading station in the form of draw that automatically opens and closes.

The court decided In re Boesch (205 USPQ 215) that optimization of a result variable is ordinarily within the skill of the art. A result effective variable is one that has predictable and well-known effects.

Bolts and clamping brackets are known for their attachment capabilities and are result effective variables. Clamps and bolt attachment further have the advantage of being removable as opposed to welding which is not removable. Finally, bolts and clamps are advantageous because the layperson is familiar with their function. It would have been within the skill of the art to modify Heid et al., Thiem et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) and use bolts or a clamping bracket to attach the processing stations as optimization of a result effective variable and to gain the above advantages.

Indication of a position being occupied by an optical means, such as a flashing light, or by an acoustic means is a well known result effective variable with the effect of notifying the technician of the status of sample. Optical and acoustic indicators have the further advantage of being universally recognized and are not bound by language

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barriers. It would have been within the skill of the art to further modify Heid et al., Thiem et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) and use optical or acoustic means to indicate a sample has been loaded as optimization of a result effective variable and to gain the above advantages.

Claims 16-17 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heid et al., Thiem et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) in view of Champseix et al. (USP 5,578,268).

Heid et al., Thiem et al. (USP 6,080,365) and Thiem et al. (USP 6,635,225) supra.

The art is silent to the claimed motor actuated drawers as a loading station.

Champseix et al. teach a device for sample transfer and analysis the includes a mobile drawer(72) that aids in sample engagement/discharge. Drawers would be further advantageous because the sample loading station can be retracted which minimizes the size of the apparatus and streamlines the device reducing accidents/damage from collisions.

It would have been within the skill of the art to modify Heid et al., Thiem et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) in view of Champseix et al. to include the sample loading station in the form of a motor actuate drawer to gain the above advantages.

Applicant traverses the rejections under 35 USC 103 on the basis that a case of prima facie obviousness has not been made above and therefore these claims cannot

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rejected under 35 USC 103. The Office maintains all of the rejections of record are proper.

Response to Arguments

Applicant's arguments filed 8/18/04 have been fully considered but they are not persuasive.

Applicant traverses the 35 USC 102 rejection over Heid et al. on the basis the claimed "plurality of processing station ..." is not claimed. Heid et al. teach multiple loading stations(6a-j) and have been properly read on the instant claims.

Applicant traverses the 35 USC 102 rejection over Theim et al.('225) on the basis the number of processing stations allocated to the loading station cannot be varied. Theim et al. teaches a plurality of reagent containers(3), that have been read on the claimed processing stations, that are controlled by control/logic circuits(24/25) and meet the claimed limitations of varying the processing stations.

Applicants' remarks concerning Theim et al. (365') were convincing and the rejection has been vacated.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander
Primary Examiner
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